

### **REMARKS**

In the Office Action,<sup>1</sup> the Examiner:

- Rejected claims 9-11 under 35 U.S.C. § 112, second paragraph, as being indefinite because of the use of a “whereby” clause; and
- Rejected claims 9-11, as understood, under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,779,321 to Black (“Black”).

By this amendment, Applicants add new claims 12-14.

### **Information Disclosure Statement**

In the Information Disclosure Statement filed March 21, 2005, U.S. Patent No. 4,189,249, the reference intended to be cited, was inadvertently listed as U.S. Patent No. 4,189,239. A new Information Disclosure Statement (“IDS”) was filed on June 19, 2009, correctly citing U.S. Patent No. 4,189,249. Applicants respectfully request the Examiner’s acknowledgement of that IDS.

### **Rejection Under 35 U.S.C. § 112, Second Paragraph**

Applicants respectfully request the Examiner’s reconsideration of this rejection.

As stated in M.P.E.P. § 2111.04 (8th ed., rev. 6, Sept. 2007):

The determination of whether each of these clauses [including “whereby” clauses] is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “‘whereby’ clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.*

Here, by ignoring the “whereby” clause of claim 9, the Examiner has in effect converted the claimed invention from that of a “jig” to that of a portion of a shopping

---

<sup>1</sup> The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

cart. The whole point of the present invention is to provide a “jig for manufacturing a reaction rod for use in connecting a chassis of a vehicle with a wheel axle housing of the vehicle.” It is hard to imagine how one of ordinary skill in the art would view the structure of a shopping cart as a form of “jig.” Even by the Examiner’s own test set out at page 3 of the Office Action (and apparently taken from M.P.E.P. § 2111.02(II) (8th ed., rev. 6, Sept. 2007), namely, that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim,” the invention as presently claimed, in view of the asserted shopping cart prior art, clearly does not satisfy even this test. Once again, it is inconceivable that one of ordinary skill in the art would use a shopping cart to structurally comprise a “jig.”

**Rejection Under 35 U.S.C. § 102(b)**

In the Office Action, the Examiner rejected claims 9-11 under 35 U.S.C. § 102(b) as being anticipated by Black. Office Action at 2. Applicants respectfully disagree with that rejection. The Examiner has wholly ignored the preamble of the pending independent claim 9, which identifies the invention as a “jig”—not a wheel structure for a shopping cart. Reference to the “jig” and the protruding “lugs” of the jig is made throughout the body of the claim.

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference . . . between the claimed invention and the prior art. If so, the recitation serves to limit the claim. . . . [A] “preamble may provide context for claim construction, particularly, where . . . that preamble’s statement of intended use forms the basis for distinguishing the prior art in the patent’s prosecution history.” [citation omitted].

M.P.E.P. § 2111.02(II).

The context of the present invention is a “jig.” By ignoring this fact, it ignores the entire concept of what the present invention is all about.

Moreover, claim 9 requires “an axis of said openings located in said transverse direction of said bottom.” The “longitudinal” direction of the shopping cart of Black, however, runs front to back, and a “transverse” direction must run side to side. Thus, the stationary back wheel brackets of Black have an opening located in the “longitudinal” direction, not the “transverse” direction as required by claim 9. The front wheel brackets swivel and have no defined opening orientation. Moreover, if they were oriented to open in the “transverse” direction, they would not be located “one at each end of said longitudinal direction of said bottom,” as is also required by claim 9.

Still further, as pointed out above, the “whereby” clause does in fact provide a structural limitation, since it requires that the “jig” have the capacity to receive a “reaction rod” as recited. The shopping cart configuration recited by the Examiner has no such capacity, and is structurally distinguished from the claimed invention on this basis as well.

Moreover, with respect to new claims 12-14, there is no disclosure in Black of any longitudinal length that is “adjustable,” as these claims now require. Support for this limitation can be found, for example, in Fig. 6 and the accompanying text at page 6, lines 30-38.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

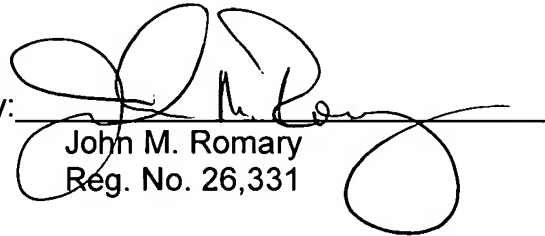
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 24, 2010

By:



John M. Romary  
Reg. No. 26,331

2030034\_1